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In re Application of :
Jin & Confalone :
Application No. 10/087,112 :
Filed: March 1, 2002 :
Attorney Docket No. PHAR2001 08841.105031 :
For: METHOD FOR THE SYNTHESIS OF 2'3'- :
DIDEOXY-2'3'-DIDEHYDRONUCLEOSIDES :

This is a decision on the petition filed October 26, 2004, entitled, "PETITION UNDER 37 CFR 1.47(A)." The petition will be treated as a petition under CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which requires all of the joint inventors to execute a supplemental declaration.¹

The petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 is **DISMISSED**.

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67" and may include an oath or declaration executed by the inventor.

Failure to respond will result in abandonment of the application.

While this waiver petition is not a petition under 37 CFR 1.47, it is evaluated the same way a Rule 47 petition is. Therefore, a grantable petition requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2).

With respect to item (1), Applicant has failed to establish that the non-signing inventor, Fuquiang Jin, cannot be located. The petition contains a declaration by Agent Susanne Hollinger who states that when she called Dr. Jin's last known telephone number, a woman identifying herself as his wife stated that Dr. Jin was in China and that he would not return before December 2004 at the earliest and gave no definite date of return. She also stated that it would not be possible to contact him before his return to the United States.

A showing of **diligence** is critical in obtaining Rule 47 status when an inventor cannot be located or reached. The evidence presented shows that Dr. Jin's unavailability to execute the supplemental declaration is a function of his being out of the country. As stated in MPEP 409.03(d), "The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47(a)." This rationale holds true in a petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67, as well.

Therefore, petitioner's best option to obtain waiver of 37 CFR 1.63 and 1.67 is to show that Dr. Jin is refusing to cooperate. Petitioner must attempt to contact Dr. Jin at his last known address in New Hope, PA in December 2004. The Office requires that petitioner mail a supplemental declaration and a complete copy of the application to Dr. Jin's last known address. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

Dr. Jin must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. When petitioner can provide evidence that Dr. Jin received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration within a reasonable amount of time, petitioner will have established Dr. Jin's refusal to join in the filing of the application.

Any written refusal to sign the declaration should be included as documentary evidence in any reconsideration petition. If there is an oral refusal, the facts surrounding the refusal should be included in a declaration by a party with first hand knowledge of the refusal. If it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.67 still has not been presented. There are two pages of declaration and neither contains information for Dr. Jin. The signing inventor must execute another declaration that contains the signer's own information and lists Dr. Jin's name, citizenship, residence, and post office address. An oath or declaration in compliance with 37 CFR 1.63 and 1.67 signed by Mr. Confalone on behalf of the non-signing inventor is REQUIRED. See MPEP 409.03(a).

Pursuant to petitioner's authorization, the \$130.00 petition fee due will be charged to deposit account no. 11-0980.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.



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